

REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1, 3-11, 13, 30-35 are pending in this application. Claims 2, 12, 14-29, and 36-39 were withdrawn. Claim 40 has been newly added by way of this reply. Claims 1, 8, 30, 31 and 40 are independent. The remaining claims depend, directly or indirectly, from claims 1, 8 or 31.

Claim amendments

Independent claim 1 has been amended by way of this reply to clarify the embodiment claimed in claim 1 comprises a method of reinforcing a monopole tower and includes using a mold that is released to leave the reinforced column. The mold itself does not become a part of the structure. Consistent with the amendment to claim 1, claims 3-7 have been amended to explicitly recite “monopole.” Also, claims 3 and 6 have been amended to correct minor informalities.

Independent claim 8 has been amended by way of this reply to explicitly recite “monopole tower.” Independent claim 8 also has been amended to correct a minor informality. Consistent with the amendment of claim 8, claims 9-13 have been amended to explicitly recite “reinforcing a monopole tower.”

Independent claim 30 has been amended to recite encapsulation the entire length of the monopole tower.

Claim 31 has been rewritten in independent form with the limitations of original claim 30 and all of claims depending from claim 30 have been amended in form and language to depend from claim 31 with substantially the same limitations of the original claims.

Independent claim 40 has been newly added with the limitations of original claim 1 and clarifying that the embodiment of claim 40 requires the entire tower to be embedded in reinforcing material, not only legs or piling. No new matter has been added, as support for new claim 40 may be found, for example, on page 6, lines 12-15 of the present application.

Additionally, claims 31 and 32 have been amended to correct minor informalities.

Rejection under 35 U.S.C. § 102

Claims 1 and 4-6 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 3,938,294 to Gaburri (hereinafter “Gaburri”). For the reasons set forth below, this rejection is respectfully traversed.

Claim 1 has been amended to recite a monopole tower consistent with the election requirement and by way of this reply to clarify that, in the embodiment of claim 1, the method include includes “holding the fluid reinforcing material in place using a releasable mold along the vertical length of the monopole tower until it solidifies to form the reinforcement column having the length of the monopole tower embedded therein,” and “releasing the mold from the reinforcement column.” No new matter has been added, as support for these amendments to claim 1 may be found, for example, claims 6, 8, 31, and 32 and publication of the Specification, paragraphs [0013], [0022] and [0023]. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

Amended independent claim 1 requires, in part, “releasing the mold from the reinforcement column.”

The MPEP § 2131 makes it clear that a claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference.

The Examiner alleges that Gaburri discloses the features of claims 1 and 4-6. However, in contrast to amended independent claim 1, Gaburri fails to disclose at least “releasing the mold from the reinforcement column,” as required by amended independent claim 1. In fact, Gaburri explicitly discloses that a casing 7 is fixed to a cross beam 14. Specifically, Gaburri discloses that each of the casings 7 has recesses 9 and the recesses 9 are used as seats for the cross beams 14 (*see Gaburri, column 3, lines 66-68 and column 4, lines 8-10 and Figures 3-8*). That is, the casing 7 disclosed by Gaburri clearly does not released from the reinforcement column, and the casing 7 is fixed to a cross beam 14. Accordingly, Gaburri fails to disclose or suggest at least releasing the mold from the reinforcement column, as required by claim 1.

Amended independent claim 1 also recites, in part, “a monopole tower.”

The examiner alleges that upright 2 corresponds to a tower (*see Office Action dated July 14, 2006, at page 2*).

However, in contrast to amended claim 1, Gaburri fails to show or suggest a monopole tower, as required by claim 1. In fact, Gaburri teaches upright 2 as a frame of a building. Specifically, Gaburri teaches a method of erecting a frame structure for a building (*see Gaburri, claim 1*). Also, Gaburri teaches that the object of the invention is to provide a load-bearing skeleton or frame structure of which can be erected much more rapidly (*see Gaburri, column 2, 10*).

lines 2-15). Thus, Gaburri clearly does not teach at least a monopole tower, as required by amended claim 1.

In view of above, Gaburri fails to show or suggest the invention as recited in amended independent claim 1. Thus, amended independent claim 1 is patentable over Gaburri. Claims 4-6, directly dependent from 1, and are deemed allowable for at least same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1 and 3 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 4,743,142 to Shiraishi et al. (hereinafter “Shiraishi”). For the reasons set forth below, this rejection is respectfully traversed.

As explained above, claim 1 has been amended. According to the amendment of claim 1, claim 3 has been amended to explicitly recite “the monopole tower”

Amended independent claim 1 also requires, in part, “holding the fluid reinforcing material in place using a releasable mold along the vertical length of the monopole tower until it solidifies to form the reinforcement column having the length of the monopole tower embedded therein,” and “releasing the mold from the reinforcement column.”

The Examiner alleges that Shiraishi discloses the features of claims 1 and 3. However, in contrast to amended independent claim 1, Shiraishi fails to disclose at least holding the fluid reinforcing material in place using a releasable mold along the vertical length of the monopole tower until it solidifies to form the reinforcement column having the length of the monopole tower embedded therein, as required by amended independent claim 1. In fact, Shiraishi explicitly discloses that a tubular cover 9 is fixed to a concrete structure 7 (see Shiraishi, column

2, lines 29-30 and Figures 1 and 2). Also, Shiraishi explicitly discloses a cover 9, not a releasable mold (*see* Shiraishi, column 2, line 32).

Specifically, Shiraishi explicitly discloses that tubular cover 9 encloses the splash zone 4, tidal zone 5 for corrosion protection (*see* Shiraishi, column 2, lines 29-30 and Figures 1 and 2). That is, the cover 9 is necessarily fixed to an appropriate portion of a steel pipe 1. Further, because Shiraishi merely discloses the tubular cover 9 as a cover, Shiraishi does not disclose the feature of holding the fluid reinforcing material in place using a releasable mold along the vertical length of the monopole tower until it solidifies to form the reinforcement column having the length of the monopole tower embedded therein, as required by amended independent claim 1.

In view of above, Shiraishi fails to show or suggest the invention as recited in amended independent claim 1. Thus, amended independent claim 1 is deemed to be patentable over Shiraishi. Claim 3 directly depends from 1, and therefore claim 3 is allowable for at least same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 8-9 and 30-34 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 1,947,413 to Hay (hereinafter “Hay”). For the reasons set forth below, this rejection is respectfully traversed.

Applicant respectfully asserts that this rejection is unclear because the Examiner only indicates the wooden pile 11 and sections 14 disclosed in Hay although claims 8-9 and 30-34 recite many features (*see* Office Action dated July 14, 2006, at page 3). Thus, Applicant respectfully submits that the rejection of record with respect to claims 8-9 and 30-34 is inconsistent with MPEP § 706, which specifies that “[t]he goal of examination is to clearly

articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” Despite the ambiguity in the rejections, Applicant respectfully traverses the rejection for the reasons set forth below.

Claim 8 has been amended to add the limitation “monopole” to “tower” consistent with Applicant’s election under the restriction requirement earlier asserted. No new matter has been added, as support for these amendments to claim 8 may be found, for example, claims 30, 31, and 32 as filed originally and publication of the Specification, paragraph [0022]. Claims 8, 9, 31 and 32 have been amended to correct minor informalities. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

Amended independent claim 8 and independent claim 30 require, in part, “a monopole tower.”

The Examiner alleges that Hay discloses a monopole tower (*see* Office Action dated July 14, 2006, at page 3). However, in contrast to amended independent claim 8 and independent claim 30, Hay fails to disclose “a monopole tower.” In fact, Hay explicitly discloses that a wharf supported by a plurality of wooden piles 11, not a monopole tower.

Specifically, Hay clearly discloses that “the numeral 10 designates the caps of the wharf, which are supported by wooden piles.” (*see* Hay, Figure 1 and column 2, lines 91-93). Further, Hay clearly discloses that “my invention relates to apparatus for forming a covering or sleeve of plastic material upon wooden pile, to protect the same from the destructive action of animal organisms, present in the water” (*see* Hay, column 1, lines 1-5). Therefore, one of the ordinary skill in the art would not reasonably interpret the wooden piles disclosed in Hay correspond to a

monopole tower. Accordingly, Hay fails to disclose or suggest at least “a monopole tower,” as required by amended independent claim 8 and independent claim 30.

Further, the grounds of rejection do not provide any disclosure or suggestion whatsoever regarding “a monopole tower,” as required by amended independent claim 8 and independent claim 30. In fact, as discussed above, the Examiner only indicates the wooden pile 11 and sections 14 disclosed in Hay.

However, “[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference” (*see In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (*citing In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 (CCPA 1981))). “[W]hen an examiner relies on inherency, it is incumbent on the examiner to point to the “page and line” of the prior art which justifies an inherency theory” (*see Ex parte Schricker*, No. 1996-2414 (USPTO Board of Patent Appeals and Interferences 2000)).

Therefore, Applicant respectfully asserts that the grounds of rejection fail to disclose or suggest all the limitations of amended independent claim 8 and independent claim 30.

In view of above, Hay fails to show or suggest the invention as recited in amended independent claim 8 and independent claim 30. Also, the grounds of rejection fail to disclose or suggest all the limitations of amended independent claim 8 and independent claim 30. Thus, amended independent claim 8 and independent claim 30 are patentable over Hay. Claims 9-13 are also deemed to be allowable for at least by virtue of their dependency. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 30 also requires encasing the tower along its entire length and Hay discloses corrosion protection only to a few inches above the water line. As such claim 30 is further patentable over Hay.

Claim 31 has been amended to include the limitation of a monopole tower, and all of claims 32 - 35 have been amended to depend directly from claim 31. As such claims 31 - 35 are also deemed to be allowable for at least the same reasons as claims 8 and 30 above.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaburri. Claim 7 has been amended to explicitly recite the limitation “monopole,” according to the amendment of claim 1. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed for at least the reasons set forth below.

As an initial matter, Applicant would like to point out that since amended claim 7 depends upon amended independent claim 1 and because the Examiner does not cite a reference, which cures the deficient teachings of Gaburri, with respect to amended independent claim 1, Applicant submits that amended claim 7 is patentable at least by reason of its dependency.

However, additionally and independently, Applicant traverses the 35 U.S.C. § 103(a) rejections shown above based on the following discussion.

Applicant respectfully asserts that Gaburri is directed to multiple corners of a building, not a monopole tower and as such is considered as non-analogous art to the present application. Accordingly, it is deemed improper to apply Gaburri in an obviousness rejection of the present claims. It is well settled that “in order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned” (*see* MPEP § 2141). As such, reference is not available under 35 U.S.C. § 103 if it is not within

the field of the inventors endeavor and was not directly pertinent to the particular problem with which the inventor was involved (*see King Instrument Corp. v. Otari Corp.*, 226 U.S.P.Q. 402 (Fed. Cir. 1985)).

Applicant respectfully asserts that the cited Gaburri reference is neither in the field of Applicant's endeavor, nor reasonably pertinent to the particular problem with which Applicant was concerned. Indeed, the field of Applicant's endeavor, as now explicitly reflected in amended independent claim 7, relates to the method of reinforcing a monopole tower (*see, e.g.*, Publication of the Specification, paragraph [0022]).

In contrast to the field of Applicant's endeavor, Gaburri relates to a method of erecting a frame structure for a building (*see Gaburri*, claim 1 and Abstract). In fact, as explained above, Gaburri teaches a method of erecting a frame structure for a building (*see Gaburri*, claim 1). Also, Gaburri teaches that the object of the invention is to provide a load-bearing skeleton or frame structure of which can be erected much more rapidly (*see Gaburri*, column 2, lines 2-15). Thus, Gaburri is removed from the field of Applicant's endeavor, i.e., the field of a reinforced monopole tower structure.

Furthermore, Gaburri is not pertinent to the problems with which Applicant was involved. As explained in the present specification, the problems with which Applicant was involved is, for example, load carrying capacity for many existing communications towers in many countries, and the claimed invention is directed toward solving this problem (among other things) (*see, e.g.*, Publication of the Specification, paragraph [0003]).

In contrast, the teachings of Gaburri are irrelevant to solving the problems that there is a need for increasing the load carrying capacity of existing tower. Instead, Gaburri is focused on initial construction of a building and to solving problems that sheathing with concrete during

construction requires expensive assembly and disassembly of molds in situ, and that joining of the cross beams to the uprights by riveting, welding, use of ties, etc. is expensive and time consuming, and requires highly skilled worker because the cross beams and the uprights generally do not fit perfectly and must be carefully adjusted by use of ties and brackets. (*see* Gaburri, column 1, lines 27-33 and lines 47-52). That is, Gaburri is focused on providing a building structure which can be erected much more rapidly and requires less labor especially less skilled worker when putting up scaffolding. Therefore, Gaburri is clearly not reasonably pertinent to the particular problem with which Applicant was concerned.

In view of the above, cited Gaburri reference is non-analogous art and it is improper to cite Gaburri against amended claim 7. Thus, amended claim 7 is patentable over Gaburri for at least this independent reason set forth above. Accordingly, withdrawal of this rejection is respectfully requested.

Further, Applicant respectfully asserts that the pending Office Action fails to provide appropriate motivation for one skilled in the art to modify the cited references. The Examiner acknowledges that Gaburri does not disclose the steps of spraying the material onto the vertical length of the tower. Nevertheless, the Examiner alleges that it would have been obvious to one skilled in the art to modify Gaburri's step to show the step of spraying the material onto the vertical length of the tower because filling a mold with cementitious material by pouring, or spraying is well known in the art as they both well known method of filling a structure with concrete (*see* Office Action dated July 14, 2006, at page 4).

However, the Examiner has not cited, nor provided, any reference to show that the above aspects of the present invention are capable of instant and unquestionable demonstration as being "well-known", as required by MPEP § 2144.03. If the Examiner is being any part of the

rejection on his personal knowledge, in accordance with 37 C.F.R. 1.104 (d) (2), Applicant hereby requests that the Examiner provide an affidavit detailing his personal knowledge for consideration and rebuttal. Furthermore, the present application *cannot be used as a guide* in reconstructing elements of prior art references to render the claimed invention obvious. (*see, In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added)). Thus, Applicant respectfully submits that no proper motivation is provided as to why one skilled in the art, without benefit of Applicant's own disclosure, would modify the cited references in order to achieve the claimed invention.

Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hay. For the reasons set forth below, this rejection is respectfully traversed.

As an initial matter, Applicant would like to point out that since claim 35 depends upon amended independent claim 31 and because the Examiner does not cite a reference which cures the deficient teachings of Hay, with respect to claim 31, Applicant submits that claim 35 is patentable at least by reason of its dependency.

However, additionally and independently, Applicant traverses the 35 U.S.C. § 103(a) rejections shown above based on the following discussion.

Applicant respectfully asserts that Hay is directed to protecting wooden piles supporting a wharf in water and is considered non-analogous art to the present application. Accordingly, it is deemed improper to apply Hay against the present claims, for the reasons set forth below.

The cited Hay reference is neither in the field of Applicant's endeavor, nor reasonably pertinent to the particular problem with which Applicant was concerned. Indeed, as explained above, the field of Applicant's endeavor, as explicitly reflected in amended independent claim

35, relates to the method of reinforcing a monopole tower (*see, e.g.*, Publication of the Specification, paragraph [0022]).

In clear contrast to the field of Applicant's endeavor, Hay relates to an "apparatus for forming a covering or sleeve of plastic material upon a wooden pile, to protect the same from the destructive action of animal organism, present in the water" (*see Hay, column 1, lines 1-5*). Thus, Hay is far removed from the field of Applicant's endeavor, i.e., the field of a reinforced monopole tower structure.

Further, Hay is not pertinent to the problems with which Applicant was involved. As explained above, the problems with which Applicant was involved is that, for example, the load carrying capacity of existing communications towers in many countries, and therefore there is a need for increasing the load carrying capacity of existing towers, and the claimed invention is directed toward solving this problem (among other things) (*see, e.g.*, Publication of the Specification, paragraph [0003]). In contrast, Hay is focused on solving problems associated with the destructive action of animal organisms, present in the water (*see Hay, column 1, lines 3-5*). Therefore, Hay is clearly not reasonably pertinent to the particular problem with which Applicant was concerned.

In view of the above, cited Hay reference is non-analogous art and it is improper to cite Hay against the claim 35. Thus, amended independent claim 35 is patentable over Hay for at least this independent reason set forth above. Accordingly, withdrawal of this rejection is respectfully requested.

Further, Applicant respectfully asserts that the grounds of rejection fails to provide a proper motivation to modify the cited Hay reference in the manner of Applicant's claimed invention for the reasons set forth below.

The Examiner acknowledges that Hay fails to disclose the step of forming the column extending the entire vertical length of the tower. Nevertheless, the Examiner alleges that it would have been obvious one ordinary skill in the art to modify Hay's step to show the step of forming the column extending the entire length of the tower because it would allow for covering and protecting of the entire column needed (see Office Action dated July 28, 2006, at page 3).

Applicant respectfully disagrees with the grounds of rejection. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teaching of that reference (see *In re Kotzab*, 55 USPQ3d at 1316-1317). Mere allegations by the Examiner that certain differences between the claimed subject matter and the prior art are obvious do not create a presumption of unpatentability (see *In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963)). It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness (see *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art (see *In re Lalu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984)).

Here, the grounds of rejection have failed to identify any aspects of Hay which shows or suggests modifying the apparatus for forming a covering upon wooden pile taught in Hay such that a concrete reinforcement column is formed extending the entire vertical length of the monopole tower, as required by claim 35.

If there is no teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, then there is no suggestion or motivation to modify the references to achieve the claimed limitations of the present invention, and the Examiner is engaging in impermissible hindsight in stating that the claims are

obvious over the applied art (*see In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and MPEP § 2143.01).

Rather, Hay teaches away from the feature of that a concrete reinforcement column is formed extending the entire vertical length of the monopole tower. Hay expressly teaches that the plastic material may be poured into a form at a point above the water level, and then the form subsequently lowered to the desired point beneath the water (*see Hay*, column 1, lines 7-11). Further, Hay expressly teaches that the caps of the wharf are supported by wooden poles (*see Hay*, column 1, lines 91-93). That is, Hay cannot possibly have wooden piles extending the entire vertical length of the wooden piles because the plastic material cannot be poured by the interference of the caps of the wharf.

In view of above, Applicant respectfully asserts that one of ordinary skill in the art would not have been motivated to modify the teaching of Hay in the specific manner proposed by the grounds of rejection for at least these reasons. Thus, claim 35 is patentable over Hay. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hay in view of in view of U.S. Patent No. 4,104, 868 to Jackson. (hereinafter “Jackson”).

As an initial matter, Applicant would like to point out that because amended claims 10 depends upon amended independent claim 8, directly or indirectly, and because the Examiner does not cite a reference which cures the deficient teachings of Hay, with respect to claim 8, Applicant submits that claim 10 is patentable at least by reason of its dependency.

However, additionally and independently, Applicant traverses the 35 U.S.C. § 103(a) rejections shown above based on the following discussion.

Amended claim 10 recites, in part, “a monopole tower” and “tension cables.”

In contrast to amended claims 10, Jackson fails to show or suggest a monopole tower, as required by claims 10. In fact, Jackson clearly teaches a chimney, not a monopole tower. Specifically, Jackson teaches chimneys or stackes for flue gases (*see* Jackson, column 1, lines 1-3). Thus, Jackson clearly does not teach a monopole tower, as required by claim 10. Also, as discussed above, Hay fails to show or suggest a monopole tower.

Further, in contrast to amended claims 10, Jackson fails to show or suggest tension cables. In fact, Jackson clearly teaches steel bars, not tension cables. Specifically, Jackson teaches that a chute 26 for in situ concrete is provided to allow mixed concrete to be poured into the interstitial gap 20 around the longitudinal reinforcing steel bars 22 (*see* Jackson, column 2, lines 22-24). Thus, Jackson does not teach tension cables, as required by claim 10. Additionally, as acknowledged by the Examiner, Hay fails to show or suggest the step of molding a plurality of spaced apart tension cable into and extending vertically through the reinforcement column (*see* Office Action dated July 14, 2006, at page 5).

Accordingly, Hay and Jackson, whether considered separately or in combination, fail to show or suggest the invention as recited in amended claim 10.

Further, Applicant respectfully asserts that Jackson is also non-analogous art to the present application and, accordingly, it is improper to apply Jackson against the present claims, for the reasons set forth below.

The cited Jackson reference is neither in the field of Applicant's endeavor, nor reasonably pertinent to the particular problem with which Applicant was concerned. Indeed, as explained above, the field of Applicant's endeavor, as explicitly reflected in amended independent claim 10, relates to the method of reinforcing a monopole tower (*see, e.g.*, Publication of the Specification, paragraph [0022]).

In clear contrast to the field of Applicant's endeavor, Jackson relates to chimneys or stacks for flue gases, particularly to method for constructing a chimney of this kind (*see* Jackson, column 1, lines 1-3). Thus, Jackson is far removed from the field of Applicant's endeavor, i.e., the field of a reinforced monopole tower structure.

Further, Jackson is not pertinent to the problems with which Applicant was involved. In fact, Jackson is focused on solving problems that "necessity for providing both circumferential and longitudinal reinforcement within the outer wall segments results in considerable expense in the precasting of these segments, and involves tricky maneuvers in ensuring that the adjacently stacked outer wall segments are properly aligned so that the longitudinal reinforcing bars can be inserted" (*see* Jackson, column 1, lines 23-29). Therefore, Jackson is clearly not reasonably pertinent to the particular problem with which Applicant was concerned, i.e., a need for increasing the load carrying capacity of existing towers, as explained above.

In view of the above, cited Jackson reference is non-analogous art, and it is improper to cite Jackson against the claim 10. Further, as discussed above, Hay is also non-analogous art. Thus, amended claim 10 is patentable over Jackson and Hay for at least this independent reason set forth above. Accordingly, withdrawal of this rejection is respectfully requested.

Moreover, the grounds of rejection have failed to identify any teaching or suggestion to modify the teaching of the cited references to achieve the specific combination of steps required by claim 10. The Office Action does not point to any specific aspect of Jackson or Hay in which any teaching or suggestion to modify the teaching of the cited references to achieve the specific combination of steps required by claim 10 (*see* Office Action dated July 14, 2006, at page 5).

Mere allegations by the Examiner that certain differences between the claimed subject matter and the prior art are obvious do not create a presumption of unpatentability (*see, In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963)). It is incumbent upon the Examiner to establish a

factual basis to support the legal conclusion of obviousness (*see In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art (*see In re Lalu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984)).

Further, as already explained above, “[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference” (*see In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (*citing In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 (CCPA 1981))). “[W]hen an examiner relies on inherency, it is incumbent on the examiner to point to the “page and line” of the prior art which justifies an inherency theory” (*see Ex parte Schricker*, No. 1996-2414 (USPTO Board of Patent Appeals and Interferences 2000)).

Therefore, Applicant respectfully asserts that the grounds of rejection fail to identify any teaching or suggestion to modify the teaching of the cited references to achieve the specific combination of steps required by claim 10. Therefore, Applicant submits that claim 10 is patentable over the cited references.

Claims 11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hay in view of Jackson as applied to claim 10 above and further in view of U.S. Patent No. 4,452,028 to Norton et al. (hereinafter “Norton”).

As an initial matter, Applicant would like to point out that because amended claims 11 depend upon amended independent claim 8, and because the Examiner does not cite a reference which cures the deficient teachings of Hay, with respect to claim 8, Applicant submits that claims 11 and 13 are patentable at least by reason of its dependency.

However, additionally and independently, Applicant traverses the 35 U.S.C. § 103(a) rejections shown above based on the following discussion.

Amended claims 11 and 13 recite, in part, “a monopole tower.”

In contrast to claims 11 and 13, Norton fails to show or suggest a monopole tower. In fact, Norton teaches a wall. Specifically, Norton teaches a method of reinforcing an existing wall having a plurality of blocks. (*see* Norton, claim 1 and Abstract). Thus, Norton clearly cannot possibly have a monopole tower, as required by claim 10. Also, as discussed above, Hay and Jackson fail to show or suggest a monopole tower, as required by amended claim 11 and 13. Accordingly, Hay and Jackson, whether considered separately or in combination, fail to show or suggest the invention as recited in amended claim 10.

Further, Applicant respectfully asserts that Norton is non-analogous art to the present application and, accordingly, it is improper to apply Norton against the present claims, for the reasons set forth below.

The cited Norton reference is neither in the field of Applicant’s endeavor, nor reasonably pertinent to the particular problem with which Applicant was concerned. Indeed, as explained above, the field of Applicant’s endeavor, as explicitly reflected in amended independent claim 10, relates to the method of reinforcing a monopole tower (*see, e.g.*, Publication of the Specification, paragraph [0022]).

In clear contrast to the field of Applicant’s endeavor, Norton relates to a reinforcement structure and method for a subterranean masonry block wall (*see* Norton, Figure 1 and column 1, lines 12-13). Thus, Norton is far removed from the field of Applicant’s endeavor, i.e., the field of a reinforced monopole tower structure.

Further, Norton is not pertinent to the problems with which Applicant was involved. As explained above, the problems with which Applicant was involved is, for example, is that there is a need for increasing the load carrying capacity of existing tower (among other things). In contrast, Norton is focused on solving problems that the methods and structures of prior art for

reinforcing subterranean masonry walls have typically been complex to construct or use (*see* Norton, column 2, lines 55-62). That is, Norton is focused on solving problems associated with reinforcing subterranean masonry walls which is complex to construct. Therefore, Norton is clearly not reasonably pertinent to the particular problem with which Applicant was concerned.

In view of the above, cited Norton reference is non-analogous art, and it is improper to cite Jackson against the claims 11 and 13. Further, as discussed above, Hay and Jackson are also non-analogous art. Thus, amended independent claims 11 and 13 are patentable over Norton, Jackson and Hay for at least this independent reason set forth above. Accordingly, withdrawal of this rejection is respectfully requested.

Moreover, the grounds of rejection have failed to identify any teaching or suggestion to modify the teaching of the cited references to achieve the specific combination of steps required by claims 11 and 13. The Office Action does not point to any specific aspect of Norton in which any teaching or suggestion to modify tensioners for a subterranean masonry block wall into a monopole tower reinforcing structure required by claims 11 and 13 (*see* Office Action dated July 14, 2006, at pages 5-6).

Mere allegations by the Examiner that certain differences between the claimed subject matter and the prior art are obvious do not create a presumption of unpatentability (*see, In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963)). It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness (*see In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art (*see In re Lalu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984)).

Further, as explained above, “[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference” (see *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (citing *In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 (CCPA 1981))). “[W]hen an examiner relies on inherency, it is incumbent on the examiner to point to the “page and line” of the prior art which justifies an inherency theory” (see *Ex parte Schricker*, No. 1996-2414 (USPTO Board of Patent Appeals and Interferences 2000)).

Therefore, Applicant respectfully asserts that the grounds of rejection fail to identify any teaching or suggestion to modify the teaching of the cited references to achieve the specific combination of steps required by claims 11 and 13. Therefore, Applicant submits that claims 11 and 13 are patentable over the cited references.

New claim

Claim 40 has been added by way of this reply. No new matter has been added, as support for these amendments may be found, for example, in paragraphs [0025] and [0031].

New claim 40 recites, in part, “a monopole tower having a vertical length,” “applying a fluid reinforcing material to embed the entire monopole tower,” and “holding the fluid reinforcing material in place along the entire vertical length of the monopole tower until it solidifies to form the reinforcement column having the entire vertical length of the monopole tower embedded therein.”

It is respectfully submitted that the prior art references cited do not include all of the limitations of new claim 40. For example, a monopole tower reinforcement method that includes applying a fluid reinforcing material to embed the entire monopole tower,” and “holding the fluid reinforcing material in place along the entire vertical length of the monopole

tower until it solidifies to form the reinforcement column having the entire vertical length of the monopole tower embedded therein" is not deemed to be shown in any of the cited references alone or in any suggested obvious combination of the cited references, and at least not in any combination of references that are considered to be analogous art. Applicant respectfully submits that new claim 40 is patentable for at least the reasons indicated.

Reconsideration of the claims as amended, withdrawal of the rejections and passing the application to allowance of claims 1, 3-11, 13, 31-35 and 40 are respectfully requested

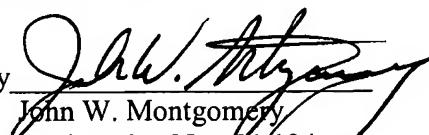
Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 17144/002002).

Dated:

Respectfully submitted,

By


John W. Montgomery
Registration No.: 31,124
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant